

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	§	
Gopal B. Avinash et al.	§	Group Art Unit: 3737
	§	
Application No.: 10/723,859	§	Confirmation No.: 9691
	§	
Filed: November 26, 2003	§	Examiner: Mehta, Parikha Solanki
	§	
For: METHOD AND SYSTEM TO	§	Atty. Docket: 139943-1/YOD/RAR/SIN
REDUCE MOTION RELATED	§	(GEMS:0256)
IMAGE ARTIFACTS DURING	§	
BREATH HOLDING	§	

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<u>September 14, 2009</u>	<u>/John Rariden/</u>
Date	John M. Rariden Reg. No. 54,388

SUPPLEMENTAL REPLY BRIEF
PURSUANT TO 37 C.F.R. §§ 41.41 AND 41.43

This Supplemental Reply Brief is being filed pursuant to 37 C.F.R. §§ 41.41 and 41.43 in response to the Supplemental Examiner's Answer mailed on August 21, 2009. Specifically, this Supplemental Reply Brief primarily addresses the fact that (1) the Examiner has improperly issued the Supplemental Examiner's Answer and (2) the Examiner has improperly raised a new ground of rejection in the improperly issued Supplemental Examiner's Answer.

Because Appellants are attempting to avoid repetition in this Supplemental Reply Brief, Appellants respectfully ask that the Board carefully consider Appellants' complete arguments set forth in the previously filed Appeal Brief (submitted to the Office on December 28, 2007) and the previously filed Reply Brief (submitted to the Office on June 27, 2008).

Procedural Issues Relating to the Present Supplemental Examiner's Answer

The Examiner Has Improperly Issued the Supplemental Examiner's Answer

First, Appellants contend that the Examiner has improperly issued the Supplemental Examiner's Answer, mailed on August 21, 2009. In particular, Appellants note that 37 C.F.R. § 41.43(a)(1) states that, in response to a reply brief, the Examiner may either (1) withdraw the final rejection and reopen prosecution or (2) furnish a supplemental examiner's answer responding to any new issue raised in the reply brief. Therefore, "[t]he Examiner cannot issue a supplemental examiner's answer if the reply brief raised no new issue." *See* M.P.E.P. § 1207.05(I).

Appellants contend that no new issues were raised in the Reply Brief submitted to the Office on June 27, 2008. M.P.E.P. § 1207.05(I) gives two examples of new issues raised in a reply brief. The first example is when an appeal brief argues that references cannot be combined because the combination would destroy the function of one of the references while the reply brief argues that the two references are nonanalogous art. The second example is when an appeal brief argues that a first feature is not cited in the applied prior art while the reply brief argues that a second feature is not cited in the applied prior art.

Appellants note that the same arguments were made in both the Appeal Brief submitted to the Office on December 28, 2007 and the Reply Brief submitted to the Office on June 27, 2008. For example, on pages 2 through 5 of the Reply Brief, Appellants argued that the Examiner improperly relied upon extrinsic evidence to define a term already fully explained in the specification of the present application. These arguments merely continued the arguments presented on pages 8 through 10 of the Appeal Brief. In addition, on pages 5 through 8 of the Reply Brief, Appellants argued that (1) the Riederer reference does not disclose a termination threshold based on motion,

(2) the Riederer reference does not disclose that a set of gated image data is selected from a set of image data, i.e., that selection is retrospective based on already-acquired data, and (3) the Riederer reference does not disclose determining if one or more scan parameters are satisfied. Again, these arguments merely continued arguments presented on pages 10 through 12 of the Appeal Brief.

Therefore, Appellants contend that no new issues were raised in the Reply Brief. As such, Appellants contend that the Examiner has improperly issued the Supplemental Examiner's Answer. Accordingly, Appellants request that the Board disregard the Supplemental Examiner's Answer and remand the application back to the Examiner to decide whether to withdraw the final rejection and reopen prosecution, which Appellants contend is the only option available to the Examiner at this point in the appeal process. *See, e.g., 37 C.F.R. § 41.43(a)(1).*

The Examiner Has Improperly Raised a New Ground of Rejection

Even assuming that the Supplemental Examiner's Answer was proper, Appellants contend that the Examiner has improperly raised a new ground of rejection in the Supplemental Examiner's Answer. In particular, the Examiner raised a new ground of rejection of claims 1-12 under 35 U.S.C. § 101. *See* Supplemental Examiner's Answer, pages 3-4.

Appellants note that 37 C.F.R. § 41.43(a)(2) states that “a supplemental examiner's answer responding to a reply brief may not include a new ground of rejection.” (Emphasis added). As further clarified by M.P.E.P. § 1207.05(I), “37 CFR 41.43(a)(2) prohibits a supplemental examiner's answer responding to a reply brief from including a new ground of rejection. After the filing of a reply brief, any new ground of rejection responding to a reply brief must be by way of reopening of prosecution. *See* MPEP § 1207.04.”

Indeed, Appellants note that the only time an Examiner may raise a new ground of rejection in a supplemental examiner's answer is when the supplemental examiner's answer responds to a remand for further consideration of a rejection. *See* M.P.E.P. § 1207.05(II). Appellants note that the Examiner is not responding to a remand for further consideration of a rejection. Rather, the Board has merely returned the application back to the Examiner for failure to address the mailing envelope. This is clearly not a remand for further consideration of a rejection. As such, this is not a situation where the Examiner may raise a new ground of rejection in a supplemental examiner's answer.

Accordingly, Appellants request that the Board disregard the Examiner's new ground of rejection of claims 1-12 under 35 U.S.C. § 101 and remand the application back to the Examiner to decide whether to withdraw the final rejection and reopen prosecution, which Appellants again contend is the only option available to the Examiner at this point in the appeal process. *See, e.g.*, 37 C.F.R. § 41.43(a)(1).

New Ground of Rejection of Claims 1-12 under 35 U.S.C. § 101

As discussed above, the Examiner has improperly raised a new ground of rejection of claims 1-12 under 35 U.S.C. § 101 in the improperly issued Supplemental Examiner's Answer. Appellants note that independent claim 1 has already been amended in a Response to a Non-Final Office Action submitted to the Office on March 5, 2007 to successfully overcome a 35 U.S.C. § 101 rejection. Appellants stand by their previous arguments presented in this Response, which were sufficient to overcome the prior 35 U.S.C. § 101 rejection. However, upon remand from the Board, should the Examiner wish to raise the new ground of rejection in a non-final office action, Appellants will gladly reconsider the new ground of rejection.

Prior Outstanding Rejections

Appellants further note that the Examiner has made no new arguments with respect to the prior outstanding rejections (i.e., the rejections under 35 U.S.C. §§ 102 and 103). More specifically, Appellants note that the Claim Rejection sections on pages 4 through 6 of the Supplemental Examiner's Answer are identical to the Claim Rejection sections on pages 3 through 5 of the Examiner's Answer. Similarly, the Response to Argument section on pages 6 through 8 of the Supplemental Examiner's Answer is identical to the Response to Argument section on pages 5 through 7 of the Examiner's Answer. As such, Appellants again request that the Board carefully consider Appellants' complete arguments set forth in the previously filed Appeal Brief and the previously filed Reply Brief.

Conclusion

Appellants respectfully request that the Board favorably consider the above arguments in addition to the arguments set forth in the Reply filed on June 27, 2008 and the arguments set forth in the Appeal Brief submitted on December 28, 2007. Appellants further respectfully request that the Board withdraw the outstanding rejections and pass the present application to allowance.

Respectfully submitted,

Date: September 14, 2009

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